

REMARKS

Claims 1 through 10 are pending in this application. All claims are rejected as obvious over a single reference, Miichi U.S. Patent No. 5,880,745.

In Paper No. 7, the Examining Staff rejected all claims under § 103 based on the combination of Miichi and Kitou U.S. Patent No. 5,870,073. Jun traversed the rejection by respectfully pointing out in Paper No. 8 that the office action failed to cite anything in the prior art containing a teaching, suggestion, or motivation to combine Miichi and Kitou, per *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998).

In Paper No. 9, the Examining Staff withdrew the § 103 rejection based on the combination of Miichi and Kitou, and replaced it with a § 103 rejection based solely on Miichi. In Paper No. 10, Jun responded by respectfully pointing out that it had been conceded in Paper No. 7 that Miichi does not have a synchronizing signal generator, although Kitou (now withdrawn as a reference because motivation to combine it with Miichi cannot be shown) does have one. Therefore, the rejection violated the all-elements rule. *In re Lowry*, 32 F.3d 1579, 32 U.S.P.Q.2d 1031 (Fed. Cir. 1994).

In addition, Jun respectfully pointed out that the claims recite a number of other limitations, among others, the limitation that there must not be any analog-to-digital converter (ADC) or phase-locked-loop circuit (PLL). While the office action claimed

that it was obvious to a person of ordinary skill to add the other limitations to Miichi's device, the office action cited no specific teaching, suggestion, or motivation in the prior art to support the assertion. In Paper No. 13, the earlier grounds of rejection were maintained.

Jun now respectfully submits that this kind of rejection is now outlawed by the intervening August 2, 2001, decision of the Federal Circuit in *In re Zurko*, which was not available to the Examining Staff at the time (June 18, 2001) that Paper No. 13 was prepared. In the *Zurko* case, the PTO sought to support a rejection based on references that lacked recited elements of the claims. The PTO tried to make up for the missing claim elements by saying that it was common sense or basic knowledge to supply them. The Federal Circuit scoffed at this transparent attempt to evade the impact of the rule of *Dembiczak* and *Rouffet*:

Finally, the deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art. As described above, the Board contended that even if the cited UNIX and FILER2 references did not disclose a trusted path, "it is basic knowledge that communication in trusted environments is performed over trusted paths" and, moreover, verifying the trusted command in UNIX over a trusted path is "nothing more than good common sense." *Ex parte Zurko*, slip op. at 8. We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to

some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise. *Baltimore & Ohio R.R. Co. v. Aberdeen & Rockfish R.R. Co.*, 393 U.S. 87, 91-92 (1968) (rejecting a determination of the Interstate Commerce Commission with no support in the record, noting that if the Court were to conclude otherwise "[t]he requirement for administrative decisions based on substantial evidence and reasoned findings—which alone make effective judicial review possible—would become lost in the haze of so-called expertise"). Accordingly, we cannot accept the Board's unsupported assessment of the prior art.

The instant final rejection, irrespective of its legal status when made, is now illegal under the Federal Circuit's intervening *Zurko* ruling. The final rejection lacks substantial evidence in the record to support it. Jun respectfully submits that after *Zurko* the instant rejection could no longer survive an appeal conference, let alone survive before the board or the Federal Circuit. Therefore, Jun respectfully submits that the rejection should be withdrawn because of the intervening *Zurko* decision.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited.

Respectfully submitted,



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